

## **REMARKS/ARGUMENTS**

Applicant has studied the Office Action dated April 2, 2007 and has made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. In the election filed on February 27, 2007, claims 1-49 and 66-69 were pending. By virtue of this amendment, claims 1-49 and 66-69 remain pending. Claims 1, 29, and 49 are amended. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- (1) acknowledged election of claims;
- (2-3) rejected claims 1-16, 18-28, 49, 66, 68, and 69 under 35 U.S.C. § 102(b) as being anticipated by Meeker (U.S. Pat. No. 2,108,206);
- (4) rejected claims 1, 15, and 17 under 35 U.S.C. § 102(b) as being anticipated by Schmitt (U.S. Pat. No. 3,754,555);
- (5-6) rejected claims 29-42, 44-48, and 67 under 35 U.S.C. § 103(a) as being unpatentable over Meeker (U.S. Pat. No. 2,108,206) in view of Green (U.S. Pat. No. 5,928,137); and
- (7) rejected claims 29 and 43 under 35 U.S.C. § 103(a) as being unpatentable over Schmitt (U.S. Pat. No. 3,754,555) in view of Green (U.S. Pat. No. 5,928,137).

### **(1) Acknowledged Election of Claims**

The Applicants wish to thank Examiner Woo for acknowledgment of Applicants' election of claims 1-49 and 66-69.

### **(2-3) Rejection under 35 U.S.C. §102(b) Meeker**

As noted above, the Examiner rejected claims 1-16, 18-28, 49, 66, 68, and 69 under 35 U.S.C. § 102(b) as being anticipated by Meeker (U.S. Pat. No. 2,108,206).

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Amended independent claims 1 and 49 recite, *inter alia*:

...  
first and second substantially rigid needles **independent** of one another and **each independently movably connected** to said actuator and having an arcuate shape... (emphasis added)

The present invention discloses a tissue retractor that includes a set of needles (4) each separately attached to an "actuator," for example, a column-shaped actuation rod (3). See, e.g., instant application, FIG. 4. Each needle is coupled to the rod by a corresponding hole in the rod that allows each needle to rotate independent of the other needle. *Id.* Although the needles move at the same time when the actuator slides forward, the movement of one of the needles is independent of and has absolutely no effect on the other.

In stark contrast, the "teeth" of the Meeker reference are "formed of a [single] yoke-shaped resilient piece of metal." Meeker, col. 2, lines 13-15 and FIG. 4. As can be seen in all of the figures of Meeker, the teeth (4) are integral with the yoke and are one **continuous** piece of metal. Therefore, the teeth of Meeker are coupled to each other and are not "independent" of one another as recited in claims 1 and 49 of the instant application. Because the teeth are coupled through the yoke, a force placed on one of the teeth of Meeker inherently places a corresponding force on the other tooth of Meeker. Therefore, there is no independence of the teeth in Meeker. Accordingly, the teeth of Meeker are also not "independently movably connected to [an] actuator," as recited in claims 1 and 49 of the instant application.

The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claim.<sup>1</sup> Because the elements in independent claims 1 and 49 of the instant application are not taught or disclosed by Meeker, the apparatus of Meeker cannot anticipate the present invention. Dependent claims 2-16, 18-28, 66, 68, and 69 are believed to be patentable as well because they all are dependent on claim 1. Accordingly, the present

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<sup>1</sup> See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The

invention distinguishes over Meeker for at least this reason. The Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome.

(6) Rejection under 35 U.S.C. §102(b) Schmitt

As noted above, the Examiner rejected claims 1, 5, and 17 under 35 U.S.C. § 102(b) as being anticipated by Schmitt (U.S. Pat. No. 3,754,555).

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Amended independent claim 1 recites, *inter alia*:

...  
first and second substantially rigid needles **independent** of one another and **each independently movably connected** to said actuator and having an arcuate shape...

The present invention discloses a tissue retractor that includes a set of needles (4) each separately attached to an "actuator," for example, a column-shaped actuation rod (3). See instant application, FIG. 4. Each needle is coupled to the rod by a corresponding hole in the rod that allows each needle to rotate independent of the other needle. Although the needles move at the same time when the actuator slides forward, the movement of one of the needles is independent of and has absolutely no effect on the other.

The Schmitt reference shows a barbed electrode with a set of prongs 24 that are "firmly attached at 28, as by welding, to the end of the piston 22." Schmitt, "col. 3, lines 1-2 and FIG. 1. Therefore, clearly, the prongs of Schmitt are fixedly coupled to each other by the piston (22) and are dependent on one other. As a result, the prongs of Schmitt are not "independent of one another and each independently movably connected to said actuator," as recited in claim 1 of the instant application.

The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected

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identical invention must be shown in as complete detail as is contained in the ... claim."

claim.<sup>2</sup> Because the elements in independent claim 1 of the instant application are not taught or disclosed by Schmitt, the apparatus of Schmitt does not anticipate the present invention. Dependent claims 15 and 17 are believed to be patentable as well because they are ultimately dependent on claim 1. Accordingly, the present invention distinguishes over Schmitt for at least this reason. The Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome.

(5-6) Rejection under 35 U.S.C. §103(a) Meeker in view of Green

As noted above, the Examiner rejected claims 29-42, 44-48, and 67 under 35 U.S.C. § 103(a) as being unpatentable over Meeker (U.S. Pat. No. 2,108,206) in view of Green (U.S. Pat. No. 5,928,137)<sup>3</sup>. Independent claim 29 has been amended to distinguish and to more clearly define the present invention over Meeker taken alone and/or in view of Green. Support for the changes is found in, for example, FIGS. 4 of the specification of the instant application. No new matter has been added.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Amended independent claim 29 recites, *inter alia*:

...  
first and second substantially rigid needles **independent** of one another and **each independently movably connected** to said actuator and having an arcuate shape...

The argument in the section entitled "(2-3) Rejection under 35 U.S.C. §102(b) Meeker" above is hereby incorporated by reference. Simply put, Meeker does not show "first and second substantially rigid needles independent of one another and each independently movably connected to said actuator."

Green teaches an endoscopic imaging and endosurgery device that has "an end effector (e.g., a grasper or scissors) comprising two operative elements 555." Green,

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<sup>2</sup> See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

<sup>3</sup> Applicants make no statement as to whether such a combination is even proper.

col. 12, lines 48-49 and FIG. 21. Green does not make up for the clear deficiencies of Meeker. In fact, Green does not even show needles at all, let alone arcuate shaped needles that are independent of one another. The “graspers” of Green work for a different purpose than that of the needles of the present invention. The “graspers or scissors” of Green apply pressure and grasp or cut an object located there between. In sharp contrast, the needles of the present invention grab tissue in a direction outwards or opposite to each other. Instant application, page 15, lines 10-20. The present invention avoids the damage that can be caused to tissue by pinching it, as the Green invention would do.

If the teeth of Meeker were replaced with the graspers of Green, the Meeker device would be inoperable. References that produce seemingly inoperative devices cannot serve as predicates for a prima facie case of obviousness.<sup>4</sup> Similarly, if the graspers of Green were replaced with the teeth of Meeker, the Green device would be incapable of pinching or cutting tissue and would also be inoperable. Clearly, Green does not show, teach, or suggest “first and second substantially rigid needles independent of one another,” as recited in claim 29 of the instant application.

It is accordingly believed to be clear that Meeker, whether taken alone or in any combination with Green neither shows nor suggests the features of claim 29. Claim 29 is, therefore, believed to be patentable over the art. Dependent claims 30-42, 44-48, and 67 are believed to be patentable as well because they all are ultimately dependent on claim 29.

#### (7) Rejection under 35 U.S.C. §103(a) Schmitt in view of Green

As noted above, the Examiner rejected claims 29 and 43 under 35 U.S.C. § 103(a) as being unpatentable over Schmitt (U.S. Pat. No. 3,754,555) in view of Green (U.S. Pat.

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<sup>4</sup> Michael L. McGinely v. Franklin Sports, Inc. (Fed Cir 2001) (“If references taken in combination would produce a ‘seemingly inoperative device,’ we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness.”); In re Sponnoble, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references teach away from combination if combination produces seemingly inoperative device); see also In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

No. 5,928,137)<sup>5</sup>. Independent claim 29 has been amended to distinguish and to more clearly define the present invention over Schmitt taken alone and/or in view of Green. Support for the changes is found, for example, in FIG. 4 of the specification of the instant application. No new matter has been added.

As stated above, in the section entitled “(4) Rejection under 35 U.S.C. §102(b) Schmitt” (the arguments of which are hereby incorporated by reference), Schmitt does not show “first and second substantially rigid needles independent of one another and each independently movably connected to said actuator.”

As also stated above, in the section entitled “(5-6) Rejection under 35 U.S.C. §103(a) Meeker in view of Green” (the arguments of which are hereby incorporated by reference), Green not only fails to show “first and second substantially rigid needles independent of one another and each independently movably connected to said actuator,” it actually teaches away from “first and second substantially rigid needles independent of one another and each independently movably connected to said actuator.”

It is accordingly believed to be clear that Schmitt, whether taken alone or in any combination with Green, neither shows nor suggests the features of claim 29. Claim 29 is, therefore, believed to be patentable over the art. Dependent claim 43 is believed to be patentable as well because it is dependent on claim 29.

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<sup>5</sup> Applicants make no statement as to whether such a combination is even proper.

### **CONCLUSION**

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicant acknowledges the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.


It is believed that no fee is due with this Amendment. However, if any fees are due with respect to Sections 1.16 or 1.17, please charge to the deposit account of the undersigned firm, Acct. No. 503,836.

**PLEASE CALL** the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

Date: July 2, 2007

By:

A handwritten signature in black ink, appearing to read "Scott Smiley", written over a horizontal line.

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